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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,548	02/09/2001	David John Zanzig	DN1999061P01	1552

7590

09/11/2002

The Goodyear Tire & Rubber Company
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EXAMINER

MAKI, STEVEN D

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-4

Office Action Summary

Application No.

09/780,548

Applicant(s)

ZANZIG ET AL

Examiner

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

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- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 6, there is no clear antecedent basis for "the said lug and groove configured portion of the sidewall". In claim 1 line 6, it is suggested to change "configured portion" to --configuration--.

In claim 1 line 1 of part (B), there is no antecedent basis for "the rubber composition of said circumferential tread".

In claim 7, there is no clear antecedent basis for "said lug and groove configured sidewall".

In claim 7, it is unclear what additional limitation is being required.

- 3) Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In claim 7, the exclusion of carbon black having the specified Iodine number is already required by claim 1.

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4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) **Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Sandstrom et al '266 (US Patent 6,046,266) in view of Japan '008 (JP 3-31008), Germany '848 (DE 2744848), Kempshall (US Patent 917,612), Gibbs (US 2592557) or Brown et al (WO 99/52720), and further in view of Sandstrom et al '761 (US 5753761).

Sandstrom et al '266 discloses a pneumatic tire for heavy load such as a truck tire comprising a tread and sidewalls.

As to the sidewall, the sidewall comprises 100 phr **diene based elastomers** including 20-60 phr *cis 1,4 polyisoprene having a Tg of -65 degrees to about -75 degrees C* and 40-80 phr *cis polybutadiene rubber having a Tg of -100 degrees C to -110 degrees C*, 40-80 phr reinforcing filler including 20-60 phr **silica** having a BET of for example 50-300 square meters per gram and 15-60 phr **carbon black** having a DBP of 65-130 cc/100g and a Iodine number of 25-85 g/kg wherein the weight ratio of silica to carbon is 1/1 to 3/1; and a **coupling agent**.

As side by side comparison of Sandstrom et al '266 and the claimed invention is presented below:

Sandstrom et al '266

Claimed Invention

100 phr elastomer

100 parts by weight rubber

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20-60 cis- 1,4 polyisoprene
(natural rubber)
with Tg of -65 to -75 °C

40-80 cis-1,4 polyisoprene
natural rubber

40-80 cis 1,4 polybutadiene
with Tg of -100 to -110 °C

20-60 cis 1,4 polybutadiene rubber

40-80 filler

55-80 filler

15-60 carbon black
DBP= 65-130 cc/100gm
Iodine Number = 25-85 g/kg

5-40 carbon black
DBP= 70-130 cm³/100g
Iodine Number 35-85 g/kg

20-60 silica
BET = 50-300 m²/g
weight ratio 1/1 to 3/1

10-70 silica
BET = 125-200 m²/g
weight ratio .3/1 to 3/1

coupling agent

coupling agent

As can be seen from the above comparison, Sandstrom '266 teaches each of the claimed ingredients for the sidewall and teaches amounts thereof which overlap / fall within the claimed ranges. Hence, Sandstrom et al '266 substantially discloses the claimed sidewall rubber composition. Sandstrom et al '266 does not recite a lug and groove configuration which extends over at least 30% of the sidewall.

As to claims 1-18, it would have been obvious to one of ordinary skill in the art to provide the tread and sidewall of the tire of Sandstrom et al '266 with a lug and groove configuration which extends over least 30% of the sidewall (claim 1) / extends over at least 50% of the sidewall (claim 2) / extends to at least the maximum section width of the tire (claim 3) since it is well

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known / conventional to provide a pneumatic tire tread and sidewall with a lug and groove configuration for traction as evidenced by Japan '008 (figures 1, 2, 4, 5) or German '848 (figures 1-2 especially figure 1) or Kempshall (figures 1-3 especially figure 1), Gibbs (figures 1-3, figure 3 clearly showing lugs extending over 30% of the sidewall) or Brown et al (figures 1-5 especially figure 5).

With respect to "lug and groove configuration", the following comments are made: First: This expression "lug and groove configuration" reads on the "configuration" shown by Japan '008 (figures 1, 2, 4, 5), German '848 (figures 1-2 especially figure 1) or Kempshall (figures 1-3 especially figure 1) or Gibbs (figures 1-3) or Brown et al (figures 1-5). Second: The expression "lug and groove configuration" fails to require the lug and groove configuration as illustrated in figures 1-3 of applicant's disclosure.

Hence: First: Sandstrom et al '266 teaches the specified composition. See above comparison. Moreover, Sandstrom et al '266 teaches using that composition *for a sidewall of a tire*. Second: The secondary art (Japan '008, German '848, Kempshall, Gibbs, Brown et al) teach the claimed lug and groove configuration. The *claimed lug and groove configuration is not different* from that shown by Japan '008, German '848, Kempshall, Gibbs and Brown et al. Moreover, the secondary art teaches using such a lug and groove configuration *for a sidewall of a tire*. Third: The teaching in Sandstrom '266 to use the specified composition *for the sidewall* and the teaching in the secondary art to use the "lug and groove configuration" *for a sidewall* of a tire

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constitutes a suggestion to use the specified composition and lug and groove configuration together.

As to the sidewall rubber composition, note the above description of the rubber composition of Sandstrom et al '266. In any event: The limitation of the specified rubber composition would have been obvious to one of ordinary skill in the art in view of Sandstrom et al '266's suggestion to use a sidewall composition comprising 100 phr diene based elastomers including 20-60 phr cis 1,4 polyisoprene having a Tg of -65 degrees to about -75 degrees C and 40-80 phr cis polybutadiene rubber having a Tg of -100 degrees C to -110 degrees C, 40-80 phr reinforcing filler including 20-60 phr silica having a BET of for example 50-300 square meters per gram and 15-60 phr carbon black having a DBP of 65-130 cc/100g and a Iodine number of 25-85 g/kg wherein the weight ratio of silica to carbon is 1/1 to 3/1 - this composition being "better suited" for a sidewall (column 5 lines 22-28).

As to the tread, it would have been obvious to one of ordinary skill in the art to use the claimed tread rubber composition in view of (a) Sandstrom et al '266's teaching to use a tread composition comprising 100 parts elastomer and 15-60 parts carbon black having a DBP of 100-150 and Iodine of 90-150 and (b) Sandstrom et al '761's teaching that *use of silica in a tread rubber composition* (which is similar to that of Sandstrom et al '266 in that its comprises 100 parts elastomer and 35-95 carbon black having a DBP of 25-140 and Iodine of 30-160) *is optional*.

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As to claims 4-6, 8 (exclusion of elastomers having a Tg in a range of -70°C to about -100°C / exclusion of specified elastomers), note that the elastomers in Sandstrom et al '266 can be cis 1,4 polyisoprene and cis 1,4 polybutadiene - this specific combination of elastomers being specifically described by Sandstrom et al '266 at column 3 which states: "blending (1) about 20 to about 60 phr ... and (2) about 40 to about 80 phr (a) ... or (b)" (emphasis added).

As to claim 7 (exclusive of carbon blacks having Iodine value greater than 85 g/kg), note Sandstrom et al '266's teaching to use carbon black having Iodine value of 25-85 for the sidewall

As to claims 9-11 (additional elastomer), note Sandstrom et al '266's teaching at col. 6 lines 59-68 to use a minor amount of additional elastomer.

As to claims 12-16, the claimed coupling agent would have been obvious in view of the teachings in Sandstrom et al '266 (column 7) regarding which coupling agents to use.

As to claim 17, use of the carbon black specified therein would have been obvious in view of Sandstrom et al '266's teaching at col. 5 lines 52-56.

As to claim 18, use of the specified carbon black for the tread would have been obvious in view of Sandstrom et al's teachings at col. 46-51.

6) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7) Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34, 41, 48, 55, 60 and 61 of copending Application No. 09/260,815 in view of Sandstrom et al (US 6046266) or Thise (US 5,284,989).

Claim 61 substantially recites the claimed tire except for the tread composition. However, it would have been obvious to provide the tread of claim 61 with the tread composition set forth in claim 1 of this application in view of the tread composition suggested by either Sandstrom et al '761 or Thise (Sandstrom et al '761 teaches 100 parts elastomer and 35-95 carbon black having a DBP of 25-140 and Iodine of 30-160 / Thise teaches 100 parts rubber and carbon black having DBP of 120-140 and Iodine of 120-160).

This is a provisional obviousness-type double patenting rejection.

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8)

Remarks

US Patent 6,046,266 is available as prior art under 35 USC 102(e). It is acknowledged that since this application was filed 2-9-01, this application is eligible for the prior art exclusion under 35 USC 103(c) - this exclusion applying to those applications filed on or after 11/29/99. However: US Patent 6,046,266 is not disqualified as a reference under 35 USC 103(c) because this application fails to contain the required evidence such as a **statement** that the application and the reference were, **at the time the invention was made**, owned by, or subject to an obligation of assignment to, the same person.

US 6046266 is also available as prior art under 35 USC 102(a) and WO 99/52720 is available as prior art under 35 USC 102(b) since (1) each of US 6046266 (which has a different inventive entity than this application) and WO 99/52720 were published before the filing date of this CIP application and (2) this application is not entitled to the benefit of the filing date of the parent application 09/260,815. See MPEP 201.08 (page 200-70, Aug 2001, WHEN NOT ENTITLED TO BENEFIT OF FILING DATE). US 6046266 cannot be excluded prior art under 35 USC 103(c) since 35 USC 103(c) relates to 102(e) type prior art and not 102(a) type prior art.

9) No claim is allowed.

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (703) 308-2068. The examiner can normally be reached on Monday to Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be


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reached on (703) 308-2058. The fax phone number for Art Unit 1733 is (703) 305-7718. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Steven D. Maki
September 8, 2002


STEVEN D. MAKI
PRIMARY EXAMINER
~~GROUP 1300~~
Av 1733 9-8-02